

REMARKS/ARGUMENTS

Claims 1 and 24 have been amended; claims 9-15 have been canceled; and claims 2-8, 16-23 and 25-28 remain unchanged. Thus, claims 1-8 and 16-28 are pending.

Claims 9-15 are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter.

Claims 1-4, 6, 7, 9, 10, 12-14, 16-19, 21, 22 and 24-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Schelling et al. (US 5,706,097).

Claims 5, 15, 20 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schelling and Yamaura (US 5,857,185).

Claims 7, 10 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schelling and Gibbon et al. (US 6,098,082).

As amended, all the pending claims of the subject application comply with all requirements of 35 U.S.C. Accordingly, Applicant requests examination and allowance of all pending claims.

The Rejection Under 35 U.S.C. § 101

Please cancel claims 9-15. Applicants reserve the right to re-submit claims 9-15.

The Rejections Under 35 U.S.C. § 102(e)

Claims 1, 16, and 24

Claim 1 has been amended to clearly recite a "computer-implemented method for generating a coversheet for a multimedia paper document comprising one or more pages, wherein a printable representation of multimedia information is printed on each page of the one or more pages...comprising printing a thumbnail image of each page in the one or more pages of the multimedia paper document on a paper medium to generate the coversheet." Here, the multimedia paper document is a paper document that has one or more pages, each page having a printable representation of multimedia information printed thereon. The recited "coversheet" is a cover sheet for such a multimedia paper document.

Schelling et al. discloses a print index having a plurality of index images representing still images, motion sequences and sound sequences on a digital recording medium. The Examiner points to this "index print" as supposedly disclosing the "coversheet" recited in claim 1. See Office Action dated August 27, 2004, p. 3-4. However, the "index print" of

Schelling et al. is merely a printed representation of multimedia information. It is not a "coversheet" for a multimedia paper document, which in turn comprises one or more pages each having a printable representation of multimedia information printed thereon. For example, the thumbnail disclosed in Schelling et al. is merely a thumbnail of the multimedia information itself. It does not disclose "printing a thumbnail image of each page of one or more pages of a multimedia paper document to generate a cover sheet," as recited in claim 1.

To put it another way, the only paper document disclosed in Schelling et al. is the "print index." See Schelling et al., Fig. 3, reference 10 (showing paper document generated by printer). However, there is absolutely no teaching or even remote suggestion for generating a "coversheet" for this print index. Thus, even assuming *arguendo* that the print index constitutes a "multimedia paper document," Schelling et al. still does not disclose or make obvious the generation of a "coversheet" for a multimedia paper document, as recited in claim 1. For the reasons stated above, applicants believe that claim 1, as amended, overcomes the rejection as being allegedly anticipated by Schelling et al.

Claims 16 and amended claim 24 each recites limitations relating to a "coversheet for a multimedia paper document" and are therefore believed to be allowable for at least reasons similar to those stated above with respect to claim 1.

Claims 4, 19, 27

Claim 4 recites, amongst other features, (1) printing a topic of interest on the coversheet and (2) printing a relevancy indicator for the topic of interest on the coversheet, wherein the relevancy indicator indicates a degree of relevancy of the multimedia paper document to the topic of interest.

The Examiner points to a subject matter descriptor (such as a title identifying the subject matter of a data file) in Schelling et al. as supposedly teaching the limitations of claim 4. However, the subject matter descriptor disclosed in Schelling et al. is merely a description or title for a file. It does not indicate "a degree of relevancy" of such a file. Furthermore, it does not indicate, in any way, how such a file relates to a "topic of interest." Thus, the mere disclosure of a description or title of a file in Schelling et al. does not teach or make obvious (1) printing a topic of interest on the coversheet and (2) printing a relevancy indicator for the topic of interest on the coversheet, wherein the relevancy indicator indicates a degree of relevancy of the multimedia paper document to the topic of interest, as recited in claim 4.

In addition, the subject matter descriptor in Schelling et al. is not printed on a "coversheet for a multimedia paper document." The subject matter descriptor is only provided on a print index in Schelling et al. As mentioned previously with respect to claim 1, this print index is not a "coversheet for a multimedia paper document." Thus, the cited portions of Schelling also fail to teach or make obvious the limitations of claim 4, for this reason as well.

Claims 19 and 27 each recites similar limitations relating to (1) printing a topic of interest on the coversheet and (2) printing a relevancy indicator for the topic of interest on the coversheet, wherein the relevancy indicator indicates a degree of relevancy of the multimedia paper document to the topic of interest. Therefore, claims 19 and 27 are believed to be allowable for at least reasons similar to those stated above with respect to claim 4.

The Rejections Under 35 U.S.C. § 103(a)

Claims 5, 20, and 28

Claim 5 recites, amongst other features, (1) printing a topic of interest on the coversheet and (2) if a page of the multimedia paper document comprises information related to the topic of interest, printing a frequency count on the coversheet proximal to a thumbnail image of the page indicating the number of times that information related to the topic of interest is located on the page.

Yamaura appears to be directed to a method for helping a user search for a particular search string (text string) in a collection of electronic documents and identifying the "optimumness" of each electronic document as it relates to the search string. To this end, Yamaura discloses the generation of the frequency of occurrence of a search string in an electronic document. However, there is simply no teaching or any suggestion of a frequency count indicating the number of times information related to a topic of interest is located on a particular page of a multimedia paper document, as recited in claim 5.

Furthermore, the frequency of occurrence of a text string in an electronic document, as disclosed in Yamaura, is not printed on a "coversheet for a multimedia paper document." Because Yamaura does not even relate to a multimedia paper document, it certainly does not disclose printing anything on a cover sheet for a multimedia paper document. As discussed above with respect to claim 1, Schelling et al. also fails to teach printing on a cover

sheet for a multimedia paper document. For these reasons, the combination of Schelling et al. and Yamaura fail to teach or make obvious the limitations of claim 5.

Claims 20 and 28 each recites similar limitations relating to (1) printing a topic of interest on the coversheet and (2) if a page of the multimedia paper document comprises information related to the topic of interest, printing a frequency count on the coversheet proximal to a thumbnail image of the page indicating the number of times that information related to the topic of interest is located on the page. Therefore, claims 29 and 28 are believed to be allowable for at least reasons similar to those stated above with respect to claim 5.

Other Claims Rejected Under 35 U.S.C. § 102(e) and § 103(a)

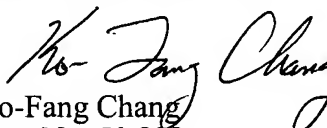
Dependent claims 2, 3, and 6-8 depend from independent claim 1. Dependent claims 17, 18, and 21-23 depend from independent claim 16. Dependent claims 25 and 26 depend from independent claim 24. Each of dependent claims 2, 3, 6-8, 17, 18, 21-23, 25 and 26 includes all of the limitations of its independent claim and is patentable for at least the reasons stated above with regard to its independent claim.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,


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